

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 35, 37, 39, 40, 42, 43, 45, and 46 will have been amended and resubmitted for consideration by the Examiner. Thus, claims 35-48 still remain pending. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 35, 36 44, 47, and 48 under 35 U.S.C § 102(b), as being anticipated by MATSUNAI (U.S. Patent No. 5,357,350). The Examiner has also rejected claims 40 and 46 under 35 U.S.C. § 102(e) as being anticipated by KUROZASA (U.S. Patent No. 5,940,188). The Examiner has rejected claims 37-39 and 45 under 35 U.S.C. § 103(a) as being unpatentable over MATUSNAI. The Examiner has rejected claims 40, 42, 43 and 46 under 35 U.S.C. § 103(a) as being unpatentable over MATSUNAI in view of KUROZASA. The Examiner has rejected claim 41 under 35 U.S.C. § 103(a) as being unpatentable over MATSUNAI in view of KUROZASA and OSTUSKA et al. (U.S. Patent No. 6,307,646).

As noted above, Applicant has amended claims 35, 37, 39, 40, 42, 43, 45 for consideration by the Examiner. Applicant respectfully traverses the above rejections based on pending claims 35-46 and will discuss these rejections with respect to the pending claims in the present application as will be set forth herein below. The

amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 35 and 36 relate to an image recording apparatus which has a copy mode and a facsimile mode. The image recording apparatus comprises a panel section which has input keys operable to input a numerical value corresponding to at least one of a number of copies in the copy mode and a telephone number of a destination in the facsimile mode. The image recording apparatus includes a display section which selectively displays one of a screen for the copy mode and a screen for the facsimile mode. A display capacity of the screen in the copy mode is smaller than a display capacity of the screen in the facsimile mode. The image recording apparatus further has a controller which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode. Claim 44 recites a related method.

Applicant's claims 37-39 relate to an image recording apparatus which has a copy mode and a facsimile mode. The image recording apparatus comprises a panel section which has an input key operable to input a numerical value corresponding to one of a number of copies in the copy mode and a telephone number of a destination in the facsimile mode, and which has a start key which starts one of copying and facsimile transmission. The image recording apparatus also comprises a controller which determines whether or not a numerical value input by the panel section exceeds a predetermined number of digits of a numerical value corresponding to the number of copies when the copy mode is set, and which, when the numerical value input by the

panel section exceeds the predetermined number of digits of the numerical value corresponding to the number of copies and when the start key is actuated, maintains the copy mode and inhibits copying. Further, the controller waits for another input by the panel section in the copy mode when the controller inhibits copying. Claim 45 recites a related method.

Applicant's claims 40-43 relate to an image recording apparatus which has a copy mode and a facsimile mode. The image recording apparatus comprises a panel section which has an input key operable to input a numerical value corresponding to one of a number of copies in the copy mode and a telephone number of a destination in the facsimile mode. The image recording apparatus also comprises a controller which determines, when the copy mode is set, whether or not an input by the panel section includes a predetermined character during the input of the numerical value corresponding to the number of copies, and which switches from the copy mode to the facsimile mode when the input by the panel section includes the predetermined character during the input of the numerical value corresponding to the number of copies. The predetermined character does not include a numerical value. Claim 46 recites a related method.

Regarding the rejection of claims 35, 36, 44, 47 and 48 under 35 U.S.C. § 102(b), MATSUNAI relates to an image forming apparatus which inputs a numeric value, sets the numeric value as the number of copies of a copy mode, and sets the numeric value as a number for specifying a destination of a facsimile mode. The image forming apparatus detects the number of figures (i.e. digits in the numeric), and performs one of the copy mode and the facsimile mode in accordance with the detected

number of figures (i.e., digits in the numeric). According to Fig. 4, MATSUNAI checks whether the number of inputs by the keys 18b reaches numeric limit (STP6). When the number of inputs by the keys 18b reaches the numeric limit (5), the copy mode is switched into the facsimile mode (STP7).

However, when the number of inputs by the keys 18b is 4 (i.e., less than the numeric limit (5) and more than the display capacity (3) of the display section 18e), the copy mode is not switched into the facsimile mode. In other words, the numeric digit limit (5) does not correspond to the display digit capacity (3) of the display section 18e in the copy mode, but rather corresponds to "numeric data, e.g., 5 which is difficult to be regarded as the number of copies or a magnification" (col. 6, lines 65-66).

Furthermore, Applicant notes that MATSUNAI shows a plurality of display areas, all labeled 18e which each display a single data (magnification, facsimile number and copies). Thus, MATSUNAI also fails to disclose a "display section which selectively displays". No single display of MATSUNAI "selectively displays" as recited.

Thus, MATSUNAI does not disclose the controller which, when the copy mode is set and *when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode*, switches from the copy mode to the facsimile mode. Rather, MATSUNAI switches when a number of digits input reaches predetermined limit value (e.g., 5), which is distinct from the display capacity of the screen in the copy mode.

With respect the Applicant's above-noted argument, the Examiner submits in the outstanding Official Action mailed on September 8, 2005 that "the Examiner does not see where the display capacity is being set at 3 of MATSUNAI". Applicant respectfully submits that Figs. 2A and 2B show the copy mode and the facsimile mode respectively.

Fig. 2A shows that a lamp next to the indication "COPY" turns ON when the copy mode is set. In Fig. 2A, three digits "123" are displayed on 18e (the upper right) and fill that display area. Thus, the display capability is limited to a maximum of three digits in Fig. 2A. On the other hand, Fig. 2B shows that a lamp "send" next to the indication "FAX" turns ON when the facsimile mode is set. In Fig. 2B, more than six digits "003500" can be displayed on 18e (the middle). Thus, Applicant submits that the display capability for the copy mode is set at 3 in MATSUNAI. In other words, the display section for the number of copies cannot display more than three digits.

Thus, MATSUNAI does not teach a controller which, when the copy mode is set and *when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode*, switches from the copy mode to the facsimile mode. In other words, MATSUNAI does not teach that the threshold value for switching from the copy mode to the facsimile mode is related to how many digits the display screen is capable of displaying in the copy mode.

On the other hand, in the present invention, the threshold value for switching from the copy mode to the facsimile mode is related to how many digits the display is capable of displaying in the copy mode. For example, the specification of the present invention describes "For example, the threshold value for input digits is set at two to allow only two digits to be displayed", at page 7, lines 12-13.

Further, the Examiner asserts in the outstanding Official Action mailed on September 8, 2005, that "MATSUNAI teaches selectively display". However, Applicant notes that Figs. 2A and 2b of MATSUNAI show that display screens 18e separately display individual data but do not selectively display. In other words, while MATSUNAI

discloses, in Figs. 2a and 2b, a plurality of discrete display regions all labeled 18e, each one of them is configured to display only a single type of information. In particular, the left-most display area only displays magnification, the middle display area only displays a phone number and the right-most display area only displays the number of copies. Thus, MATSUNAI does not disclose the recited "display which selectively displays one of a screen for the copy mode and a screen for the facsimile mode". Rather, each of the display sections of MATSUNAI are always displayed and each individual section is used as appropriate. However, there is no selective display of screens.

Furthermore, the Examiner asserts in the outstanding Official Action mailed on September 8, 2005 that "Fig. 4, STP 6-STP 8 teaches the threshold value is how many digits the display screen is capable of display in the copy mode". However, STP 8 of Fig.4 "CHANGE DISPLAY SECTION 18e FOR FAX " is related to STP 7 of Fig.4 "SELECT FAX MODE". Thus, Fig.4, STP 6-STP 8 does not teach that the threshold value is how many digits the display screen is capable of display in the copy mode. Rather, in MATSUNAI as explained above, the display screen 18e for a facsimile mode is different from the display screen 18e for a copy mode (i.e., a different screen is utilized). Thus, in MATSUNAI, when the facsimile mode is selected, the display screen 18e for the copy mode needs to be changed to the display screen 18e for the facsimile mode. In MATSUNAI, switching between the fax mode and the copy mode occurs when a number of digits is input that is not related to the maximum display capacity of the display utilized for the copy mode. In other words, as noted above, switching from copy mode to fax mode occurs when the number of digits input is 5 (STP 6) while the maximum number of digits displayable in the copy mode display section (18e right-most

section) is three digits. Thus, and contrary to the Examiner's assertions at the top of page 11 of the Action, in MATSUNAI there is no teaching of a relationship between the threshold value for input digits in the copy mode as related to the maximum number of digits displayable on the display screen in the copy mode.

Accordingly, MATSUNAI does not comply with the requirements of claims 35, 36, 44, 47 and 48, as it does not disclose all of the features recited therein.

Therefore, it is respectfully submitted that as the features recited in Applicant's claims 35-36, 44 and 47-48 are not disclosed in MATSUNAI cited by the Examiner, these claims are patentable thereover.

Regarding the rejection of claims 40 and 46 under 35 U.S.C. § 102(e), KUROZASA relates to an image processing and communication apparatus which performs a copy request through facsimile communications using a mark sheet. KUROZASA discloses an application switching key 98 utilized for manually switching between a copy mode and a facsimile mode (Fig. 2 and col. 7, lines 28-32).

However, KUROZASA does not disclose a controller which determines, when the copy mode is set, whether or not an input by the panel during the input of the numerical value corresponding to the number of copies includes a predetermined character. KUROZASA also does not disclose a controller which switches from the copy mode to the facsimile mode when the input by the panel during the input of the numerical value corresponding to the number of copies includes the predetermined character, the predetermined character not including a numerical value. Rather, in KUROZASA, the application switching key 98 must be manually pushed before a copy mode or a facsimile mode is set, since the application switching key 98 is utilized for setting the

copy mode or the facsimile mode (Fig. 5). Thus, claims 40 and 46 are clearly distinguished over KUROZASA.

Therefore, it is respectfully submitted that as the features recited in Applicant's claims 40 and 46 are not disclosed in KUROZASA cited by the Examiner, and these claims are patentable thereover.

Regarding the rejection of claims 37-39 and 45 under 35 U.S.C. § 103(a) as being unpatentable over MATSUNAI, the Examiner asserts in the outstanding Official Action mailed on September 8, 2005 that 0 value is not a value corresponding to the number of copies and that MATSUNAI teaches the numeric key would allow a user to enter numeric values from 0 to 9.

However, in claims 37-39 and 45, the controller does not determine whether or not the numerical value input by the panel section has a 0 value. Rather, in claims 37-39 and 45, the recited controller determines whether or not the numerical value input by the panel section exceeds a predetermined number of digits of the numerical value corresponding to the number of copies when the copy mode is set. The controller of claims 37-39 and 45 also maintains the copy mode and inhibits a start of copying, when the numerical value input by the panel section exceeds the predetermined number of digits of the numerical value corresponding to the number of copies. MATSUNAI does not contain any disclosure regarding the combination of features recited in claims 37-39 and 45.

Thus, MATSUNAI does not comply with the requirements of claims 37-39 and 45, as it does not disclose all of the features recited therein.

Therefore, it is respectfully submitted that as the features recited in Applicant's claims 37-39 and 45 are not disclosed in MATSUNAI cited by the Examiner, these claims are patentable thereover.

Regarding the rejection of claims 40-43 and 46 under 35 U.S.C. § 103(a) as being unpatentable over MATSUNAI in view of KUROZASA, the Examiner at least admits in the outstanding Official Action mailed on September 8, 2005 that "MATSUNAI does not teach that the input includes a predetermined character which is not a numerical value that allowed the controller to detect to switch the image recording apparatus from the copy mode to the facsimile mode".

Thus, claims 40-43 and 46 are clearly distinguished over MATSUNAI.

Regarding KUROZASA, as discussed above, KUROZASA does not disclose a controller which determines, when the copy mode is set, whether or not an input by the panel during the input of the numerical value corresponding to the number of copies includes a predetermined character. KUROZASA also does not disclose a controller which switches from the copy mode to the facsimile mode when the input by the panel during the input of the numerical value corresponding to the number of copies includes the predetermined character, the predetermined character not including a numerical value. Rather, in KUROZASA, the application switching key 98 must be pushed before a copy mode or a facsimile mode is set, since the application switching key 98 is utilized for setting the copy mode or the facsimile mode (Fig. 5). Thus, claims 40 and 46 are clearly distinguished over KUROZASA.

Therefore, it is respectfully submitted that as the features recited in Applicant's claims 40-43 and 46 are not disclosed in KUROZASA cited by the Examiner, these

claims are patentable thereover. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since MATSUNAI and KUROZASA (in any proper combination) do not disclose the combination of features recited in Applicant's claims 40-43 and 46.

Regarding the rejection of claim 41 under 35 U.S.C. § 103(a) as being unpatentable over MATSUNAI in view of KUROZASA and OTSUKA, as discussed above, neither MATSUNAI nor KUROZASA nor any proper combination discloses the combination of features recited in independent claim 40 on which claim 41 depends. OTSUKA merely disclose a pause character (Fig. 2) but does not teach functioning of the pause character as recited.

Therefore, it is respectfully submitted that as the features recited in Applicant's claim 41 is not disclosed in OTSUKA cited by the Examiner, these claims are patentable thereover. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since none of MATSUNAI, KUROZASA, and OTSUKA (in any proper combination) discloses the combination of features recited in Applicant's claim 41.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues are being presented and no new claims are being submitted. It is believed that the Examiner has searched and considered the new claim language as they merely

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clarify the invention. The Examiner is respectfully requested to exercise his discretion in this regard.

**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims and resubmitted them for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof that distinguish the same from the cited references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which has been made in this amendment, which has not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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